

Notice of Allowability

Application No.

10/646,423

Examiner

Rebecca L. Anderson

Applicant(s)

WALTER ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 25 July 2006.
2. ☒ The allowed claim(s) is/are 1-13.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/002,939.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 20060905.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

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DETAILED ACTION

Claims 1-13 are currently pending in the instant application and appear allowable over the prior art of record.

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Alan Stempel on 5 September 2006.

The application has been amended as follows:

1. Amend the status identifier of claim 9 from "(Original)" to --(Currently amended)--.
2. Delete claim 14.

Priority

Applicant has complied with the conditions for receiving the benefit of an earlier filing date under 35 USC 119 as applicant has provided a translation of the non-English language provisional application No. 60,251,055 and has provided a statement that the translation is accurate. Furthermore, a translation of the foreign priority papers has been made of record in accordance with 37 CFR 1.55.

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Appropriately, the 35 USC 102 and 103 rejections of the claims are withdrawn as WO 01/16130 is thus removed as prior art as the effective date of the application, for the purpose of overcoming prior art is November 1, 2000.

Terminal Disclaimer

The terminal disclaimer filed on 25 July 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent No. 6,794,395 has been reviewed and is accepted. The terminal disclaimer has been recorded. Therefore, the rejection of claims 1-13 on the ground of nonstatutory obviousness-type double patenting is withdrawn.

Response to Amendment

Applicants' amendment and remarks filed 25 July 2006 have overcome: the objection to claim 12 as containing informalities; the objection to claim 13 as being an improper multiple dependent claim; the objection to claims 1-13 as containing non-elected subject matter; and the 35 USC 112 2nd paragraph rejection of claims 1-4, 6-11 and 13.

The amendment to the claims in US Patent Application 10/646,495 has amended the claims to exclude subject matter instantly claimed by applicants. Therefore, the provisional rejection under 35 USC 101 as claiming the same invention is withdrawn.

The provisional rejection of claim 13 on the ground of nonstatutory obviousness-type double patenting over copending Application NO. 10/640,929 is withdrawn as the provisional nonstatutory obviousness-type double patenting rejection is the only rejection remaining in this earlier filed of the two pending applications. MPEP 804 states that if

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the obviousness-type double patenting rejection is the only remaining rejection in the earlier filed of the two pending applications, the examiner should withdrawn that rejection and permit the earlier filed application to issue as a patent without a terminal disclaimer.

Reasons for Allowance

The following is an examiner's statement of reasons for allowance. This invention relates to products of the formula (I). The novel and nonobvious aspect of this invention involves the substituents R2 and R7. The closest prior art of record fails to teach or suggest applicants' instantly claimed invention.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday 5:30AM to 2:00PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

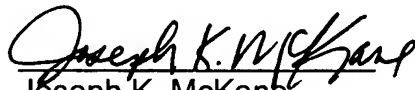
The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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